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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/090,299 | 03/04/2002 | Basil Naji | BALDS2.025AUS | 6646 |
| 20995 | 7590 | 12/02/2005 | EXAMINER | |
| KNOBBE MARTENS OLSON & BEAR LLP | | | | MARCANTONI, PAUL D |
| 2040 MAIN STREET | | | | ART UNIT |
| FOURTEENTH FLOOR | | | | PAPER NUMBER |
| IRVINE, CA 92614 | | | | 1755 |

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 10/090,299 | NAJI ET AL. |
| Examiner | Art Unit | |
| | Paul Marcantoni | 1755 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 October 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 and 3-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1 and 3-14 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____ .

The applicants' 10/17/05 amendment and response is acknowledged but not convincing.

35 USC 102/103:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gebhardt '985, Onan et al. '521, Groppo Jr et al. '230, or Sakai et al. '013.

Gebhardt teaches a composition comprising fly ash cenospheres and even teaches an overlapping ranges of amounts for fly ash constituent components in Table 1 column 2 thus anticipating the instant invention. Even if not anticipated, overlapping ranges of amounts would have been *prima facie* obvious to one of ordinary skill in the art. Note that applicants also use “comprising” claim language which does not exclude the other components of the Gebhardt reference. Comprising leaves the claim open for the inclusion of unspecified ingredients even in major amounts. Ex parte Davis et al., 80 USPQ 448 (PTO Bd of App.1948). Also, although Gebhardt does not teach the preamble of the fly ash composition (dewatering aid) which is an intended use, the discovery of a new property or use of a previously known composition cannot impart patentability to the claims to the known composition (see *In re Spada* 15 USPQ2d (CAFC 8/10/90) 1655-1658.

Onan et al. '521 teach a Class C fly ash composition comprising an average particle size of 9 microns and a maximum particle size of 36 microns anticipating applicants claims. Even if not anticipated, overlapping ranges of amounts of the same component claimed would have been *prima facie* obvious to one of ordinary skill in the art. (See Table I in col.4, lines 45-55).

Groppi Jr et al. '230 teach that the final fly ash composition has fly ash particles that are less than or equal to 45 microns anticipating applicants' claims. Even if not anticipated, overlapping ranges of amounts of the same component claimed would have been *prima facie* obvious to one of ordinary skill in the art (see claim 4 in col.6).

Sakai et al. '013 teach a fly ash for a cement composition, said fly ash generally has an average particle size of from 10 to 30 microns (see col.3, lines 48-50) anticipating applicants' claims. Even if not anticipated, overlapping ranges of amounts of the same component claimed would have been *prima facie* obvious to one of ordinary skill in the art.

It is also noted above that although some of the references do not teach the applicants' intended use as a dewatering aid, the new use of a known composition is not a patentable distinction and *In re Spada* was cited from MPEP 2100 Chapter on Patentability:

“Products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) (Applicant argued that the claimed composition was a pressure sensitive adhesive containing a tacky polymer while the product of the reference was hard and abrasion resistant. “The Board correctly found that the virtual identity of monomers and procedures sufficed to support a *prima facie* case of unpatentability of Spada’s polymer latexes for lack of novelty.”).

35 USC 103:

It is the examiner's position that the new use of a known composition is not a patentable distinction as stated above. However, in order to make it clear that the use of fly ash as a “dewatering aid” is old in the art, the following rejection has also been added:

Claims 1 and 3-14 are rejected under 35 U.S.C. 103(a) as obvious over Gebhardt '985, Onan et al. '521, Groppo Jr et al. '230, or Sakai et al. '013 in view of McOnie et al. '832, Blankenburg et al. (abstract), and Otte-Witte (abstract).

All of the primary references teach a composition of fly ash as stated above that teaches overlapping ranges for particle sizes. The primary references do not appear to teach the intended use of fly ash as a dewatering aid. The applicants claim fly ash as a dewatering aid for a cement slurry. Yet, the secondary references of McOnie et al. '832, Blankenburg, and Otte Witte all teach adding fly ash to a water slurry containing solids to remove water. McOnie et al. '832 teach that fly ash is a good absorber of water and in his application is used to draw out water of secondary sludge (col.4, lines 30-34). It is the examiner's position that if fly ash is known as a water absorber in the art that it can be used for any slurry containing water to remove water. Blankenburg likewise also teaches that fly ash is particularly known in the art as a sludge dewatering aid. Finally, Otte-Witte teach that fly ash can be used in combination with sludge and cement which would be in an aqueous slurry form and it is clear that fly ash is already known as a water absorber or dewatering aid so its usage in a sludge slurry alone or a sludge and cement slurry would have thus been obvious to one of ordinary skill in the art.

Citation of Related Art

It is noted that the examiner has also cited additional references as art relevant to applicants' invention and available at the time of their invention but not used in the rejection above. It is expected the references above are sufficient. Nevertheless, Raba Jr et al. '736, Mewes et al. '275, Melhuish (GB 2276875 abstract), Benitez et al. (abstract), and Apro et al. (HU 31027) all teach fly ash is known in the art as a dewatering aid. These references can be found on the PTO-892 form.

Objection to the Original Specification:

The Examples 1 through 4 are objected to under the first paragraph of 35 USC 112 as the specification does not clearly enable one to make or practice the invention.

The applicants are referred to the provided tables for each example and specifically are referred to the Fly Ash (larger size fraction) and Fly ash (smaller size fraction) components under "Slurry Composition". What is the specific particle size range utilized for all these examples that was deemed the larger fly ash fraction and what is the specific particle size range for these examples that was deemed the smaller size fraction? Please provide the specific particle size or particle size range for the large size and small size fractions that were used for the examples so the disclosure is clear in this regard.

New Matter:

Claims 1 and 3-14 are rejected under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

The new limitation added to claim 1 of wherein a first portion of the particulate material has a particle size of 10 microns or less and a second portion of the particulate material has a particle size of 100 microns or less is new matter. Applicants do not have literal support for "a particle size of 10 microns or less" for the first portion nor do they have literal support from their specification for the second portion of "100 microns or less". These limitations are not found in the original disclosure and it is outside the scope of applicants' invention to include these new particle size limitations.

It is also noted that applicants use the claim language "around 10 microns" for the maximum particle diameter (see claim 10) and "about 10 microns" as stated in paragraph [0033]. Applicants should be consistent with both terms and it is suggested they consider substituting ---about--- for "around" in claim 10. Further, there is a problem with applicants claiming that the "first portion of the particulate material has a particle size of 10 microns or less." This is because applicants use "about" or "around" claim language (about 10 microns or around 10 microns) in their specification and original claims. About permits some tolerance and can include all values approximating 10 microns particle size above and below that particle size. Thus, it is not seen that applicants can have support for 10 microns or less. They may have support, however, for --about 10 microns or less--- but not "10 microns or less". Applicants are limited by the language of their original disclosure using about or around.

In claim 10, the limitation but an average particle size of greater than 10 microns which was added in response to applicants first office action as a new limitation on 6/25/04. The examiner has searched the original claims and the original specification and cannot find any support for this limitation. It was overlooked and should have been rejected after this amendment as new matter but was inadvertently omitted. It is now presented as new matter not supported by original disclosure.

35 USC 112 Second Paragraph:

Claims 1 and 3-14 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The terms wherein a first portion of the particulate material has a particle size of 10 microns or less and a second portion of the particulate material has a particle size of 100 microns or less in claim 1 is indefinite. It is indefinite because the particle size of the second portion of particulate material has a range of 100 microns or less which encompasses and thus overlaps the first portion particulate material of about 10 microns or less. There is thus no way to distinguish the first portion from the second portion because the second portion is inclusive of the first portion.

Response:

The applicants argue the intended use of Gebhardt's fly ash as a watering aid. Yet, the new use of a known composition is not a patentable distinction as stated above in the *In re Spada* decision. Also, the applicants newly added particle size range is new matter and indefinite for the reasons provided above. It is the examiner's position that this particle size range for Gebhardt's fly ash still overlaps the claimed invention.

Yoon has been withdrawn from the rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
Art Unit 1755